



[Billing Code 4140-01-P]

DEPARTMENT OF HEALTH AND HUMAN SERVICES

National Institutes of Health

Prospective Grant of Exclusive License: Device and System for Expression
Microdissection (xMD)

AGENCY: National Institutes of Health, HHS

ACTION: Notice

SUMMARY: This is notice, in accordance with 35 U.S.C. 209(c)(1) and 37 CFR Part 404.7(a)(1)(i), that the National Institutes of Health, Department of Health and Human Services, is contemplating the grant of a start-up exclusive commercial license agreement to practice the inventions embodied in International PCT Application S/N PCT/US03/23317 (HHS Ref. No. E-113-2003/0-PCT-02) filed July 23, 2003, which published as WO 2004/068104 on August 12, 2004, now expired; U.S. Patent No. 7,709,047 (HHS Ref. No. E-113-2003/0-US-03) issued May 4, 2010; U.S. Patent Application S/N 12/753,566 (HHS Ref. No. E-113-2003/0-US-07) filed April 2, 2010; U.S. Patent No. 7,695,752 (HHS Ref. No. E-113-2003/1-US-01) issued April 13, 2010; U.S. Patent Application S/N 12/713,105 (HHS Ref. No. E-113-2003/1-US-02) filed February 25, 2010; Australian Patent No. 2003256803 (HHS Ref. No. E-113-2003/0-AU-04) issued January 21, 2010; Australian Patent Application S/N 2009250964 (HHS Ref.

No. E-113-2003/0-AU-06) filed July 23, 2009; and Canadian Patent Application S/N 2513646 (HHS Ref. No. E-113-2003/0-CA-05) filed July 23, 2003, all entitled; “Target Activated Microtransfer;” and all continuing applications and foreign counterparts to xMD Diagnostics, LLC, a company having a place of business in Maryland. The patent rights in these inventions have been assigned to the Government of the United States of America.

The prospective exclusive license territory may be “worldwide”, and the field of use may be limited to the following below.

“Devices, systems, kits and related consumables, and methods using devices, systems, kits and related consumables, for micro-dissection of biological specimens, as covered by the Licensed Patents Rights (the “Exclusive Field”). xMD Diagnostics, LLC (xMD) shall be the only entity granted rights in the Exclusive Field for commercial or other “for-profit purposes. Methods, kits, and related consumables that are used independent of the devices or systems by individual researchers employed at non-profit and academic institutions, if such kits were built by the researchers themselves from component parts and used for their own individual research purposes, shall not infringe xMD’s rights. Diagnostic services performed using devices, systems, kits and related consumables purchased from xMD (or xMD’s authorized distributor(s)) by those persons employed at non-profit and academic institutions that purchased the devices, systems, kits and related consumables used in the diagnostic services, shall not infringe xMD’s rights.”

DATE: Only written comments and/or applications for a license which are received by the NIH Office of Technology Transfer on or before [Insert date 15 days from date of publication of notice in the FEDERAL REGISTER] will be considered.

ADDRESS: Requests for copies of the patent application, inquiries, comments, and other materials relating to the contemplated exclusive license should be directed to: Kevin W. Chang, Ph.D., Senior Licensing and Patenting Manager, Office of Technology Transfer, National Institutes of Health, 6011 Executive Boulevard, Suite 325, Rockville, MD 20852-3804; Telephone: (301) 435-5018; Facsimile: (301) 402-0220; E-mail: changke@mail.nih.gov.

SUPPLEMENTARY INFORMATION: The subject technologies are methods, devices, and kits for target activated transfer of a target from a biological sample such as a tissue section, comprising: contacting the biological sample with a reagent that selectively acts on the target within the biological sample; placing a transfer surface adjacent the biological sample, wherein the reagent produces a change in the transfer surface by heating the target; heating the target to produce a change in the transfer surface and selectively adhere the target to the transfer surface, or to selectively increase permeability of the transfer surface to the target; and selectively removing the target from the biological sample by removing the transfer surface and the adhered target from the biological sample, or by moving the target through the transfer surface.

The prospective start-up exclusive commercial license will be royalty bearing and will comply with the terms and conditions of 35 U.S.C. 209 and 37 CFR Part 404.7. The

prospective start-up exclusive commercial license may be granted unless within fifteen (15) days from the date of this published notice, the NIH receives written evidence and argument that establishes that the grant of the license would not be consistent with the requirements of 35 U.S.C. 209 and 37 CFR Part 404.7.

Applications for a license in the field of use filed in response to this notice will be treated as objections to the grant of the contemplated exclusive license. Comments and objections submitted to this notice will not be made available for public inspection and, to the extent permitted by law, will not be released under the Freedom of Information Act, 5 U.S.C. 552.

May 8, 2013
Date

Richard U. Rodriguez,
Director
Division of Technology Development and Transfer
Office of Technology Transfer
National Institutes of Health

[FR Doc. 2013-11357 Filed 05/13/2013 at 8:45 am; Publication Date: 05/14/2013]